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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,005	05/04/2001	Chian-Min Richard Ho	M-5333-1C US	1848

34036 7590 01/30/2004

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EXAMINER
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FREJD, RUSSELL WARREN

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 01/30/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/849,005

PR29  
Applicant(s)

HO ET AL.

Examiner

Russell Frejd

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-46 and 53-79 is/are allowed.
- 6) ☒ Claim(s) 47 is/are rejected.
- 7) ☒ Claim(s) 48-52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12. 6) ☐ Other: \_\_\_\_\_

In re Application of: HO et al.

***Examination of Application #09/849,005***

1. Claims 11-79 of application 09/849,005, filed on 4-May-2001, are presented for examination. This application is a CON of 08/954,765, filed on 20-October-1997, now U.S. Patent No. 6,292,765, issued on 18-September-2001.

***Information Disclosure Statement Remarks/Objection***

2. The Information Disclosure Statement received on 10-October-2003, detailed the submission of two PTO-1449's, namely Part A and Part B. Part A was said to consist of 28 documents listed on 3 sheets of the IDS, and Part B was said to consist of 24 sheets of the IDS. There was, however, no further description of the documents listed in Part B, and there clearly was no stack of documents received with the file. However, the examiner notes a stack of unmarked microfiche cards in the file, and was wondering if applicant could identify the stack as the missing documents. Upon confirmation, the documents listed on the 24 IDS sheets will be considered by the examiner.

Also, it is noted that the article by Heinrich et al., identified by applicant as being in the Description of the Invention, is not included on any of the 1449's submitted by the applicant, and will not be considered as prior art of record by the examiner.

***Claim Rejections under 35 U.S.C. § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

In re Application of: HO t al.

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371<sup>©</sup> of this title before the invention thereof by the applicant for patent.

3.1 Claim 47 is rejected under 35 U.S.C. § 102(e) as being anticipated by Weir et al., patent no. 5,729,554.

3.2 Weir et al. disclosed the invention as claimed, including:

simulating the functional behavior of a circuit in response to a first test vector [col. 6, line 9];

wherein the simulation has a current state prior to simulating [col. 6, line 7];

automatically restoring the simulation to current state without passing through a reset state [col. 6, lines 1-41]; and

after restoring, simulating in response to a second vector [col. 6, lines 1-41].

### ***Claim Objections***

4. Claims 48-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In re Application of: HO et al.

***Allowable Claims***

5. Claims 11-46 and 53-79 are deemed allowable over the prior art of record at this time.

***Response Guidelines***

6. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

7. **Any response to the Examiner in regard to this non-final action should be**

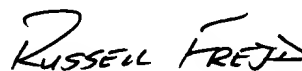
**directed to:** Russell Frejd, telephone number (703) 305-4839, Monday-Friday from 0630 to 1500 ET, or the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature should be directed to the Tech Center 2100 receptionist, telephone number (703) 305-3900. The TC 2100 Customer Service telephone number is (703) 306-5631.

**mailed to:** Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** (703) 872-9306

***Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Fourth Floor (Receptionist).***

Date: 26-January-2004



**RUSSELL FREJD  
PRIMARY EXAMINER**